

Supreme Court of the United States.

October Term, 1901.

No. 96.

CLARENCE M. BUSCH, Appellant

vs.

JOSHUA W. JONES and THE W. O. HICKOK MANUFACTURING COMPANY, APPELLEES.

Petition for a Re-Hearing.

To the Honorable Justices of said Court:

The Appellees in the above entitled Cause respectfully pray that the Court will rehear and reconsider the matters decided March 17, 1902, so far as they relate to the question of the validity of the fifth claim of the Patent No. 204,741, here in suit; and that an Order be entered affirming the judgment of the Court of Appeals of the District of Columbia.

The grounds upon which this application is made are:

(a) That the learned Court, in their said decision, as evidenced by the written Opinion filed March 17, 1902, giving the reasons for the said decision, in holding that the fifth claim of the Patent in suit, which is as follows:

"The process herein described for treating folded printed sheets of paper in dry-pressing, the same consisting of subjecting a collection of such sheets to pressure without the use of fuller-boards, and while under such pressure tying them into compact bundles with end boards, then removing them immediately from the press, and allowing them to remain tied sufficiently long to fix and complete dry-pressing,"

describes the "mere operation and effect of the press" and is therefore invalid, inadvertently overlooked the fact that said claim demands, as the conditions of the carrying out of the process, certain things which are not essential to the mere operation and effect of the press, but are in addition thereto, and which were, before the invention set forth in said claim, wholly unknown in the art of dry-pressing, as follows:

1. *Dispensing with the use of fuller-boards.*—It is shown by the testimony that, in the only process of dry-pressing in use prior to the invention by the patentee Jones, "fuller" or "press" "boards," interspersed at very short intervals between the sheets—a single sheet in fine work, or, in work less fine, at most three to six sheets, being placed between a couple of "fuller-boards"—were necessary to produce the effacement of the type indentations. It is evident that the mere effective operation of the press demands neither the use nor the omission of fuller boards, which, so far as concerns such operation, may be omitted, as demanded by the claim in question, or, conforming to the only practice known prior to the invention in controversy, may be interposed between the sheets in the press and subsequently in the bundle. But one of the discoveries of the inventor, embodied in the claim, is that fuller boards, which had always before his invention been used in dry-pressing, may be dispensed with, thereby accomplishing a great saving in time and labor and in cost of materials; and—by so omitting one of the steps theretofore always practiced in the operation of dry-pressing, viz: inserting, by hand, the printed sheets between the fuller boards—rendering the process a new one, and patentable within the rule laid down by this Court in the case of *Lawther v. Hamilton*, 124 U. S., 1.

2. *Use of end-boards.*—The claim in controversy demands the tying of sheets "into compact bundles with end boards." These end boards are in practice "hard wood boards," and are thus described in the Specification (Record, p. 95):

"They are used on the ends of the bundle of the paper under treatment to distribute the pressure over the whole area of the ends of the bundle, and also to prevent cutting or marring of the paper by the twine or other tying material. Said end boards are made of any suitable material affording strength and rigidity at little cost and of suitable size to nearly match the size of the folded work."

The use of strong and rigid end boards, "of suitable size to nearly match the size of the folded work," and suitable "to distribute the pressure," is not necessary for the practical and effective operation of the press, it being proved by Appellant's witnesses that, in the operation of tying up bundles of already dry-pressed sheets in the Palmer Press, "pieces of pasteboard or binder's board"—"paper would answer just as well"—were sufficient "to protect the sheets from being soiled" and cut by the cords with which they were tied. But for the operation of dry-pressing or removing the type-indentations, it is necessary that pressure shall, for a considerable time, be kept uniformly distributed over the whole face of the printed sheet, and it was one of the Patentee's discoveries, embodied in his fifth claim, that by the use of end-boards such as are described in his Patent, pressure applied in the press could, in the bundle, be kept thus distributed, and that thereby the operation of dry-pressing begun in the press could be completed in the bundle. The use of "end boards" is thus a necessary condition of the carrying out of the process, but is not necessary to the mere operation of the press.

3. *Folding the Sheets.*—In the old process of dry-pressing the sheets were laid out flat between fuller-boards, while in the present process the sheets are folded and fuller-boards are dispensed with. It is pointed out in the testimony that folding is an essential condition of the carrying-out of the

process. As a condition of dry-pressing, it was new with the inventor Jones and may be considered as embodied in his claim. And, as the sheets are folded by a separate machine prior to their insertion in the press, this necessary condition of the carrying-out of the process is wholly apart from the mere operation of the press.

(b) In holding that "the process is the whole value, the sole purpose of the press," the learned Court inadvertently overlooked the fact that the press is applicable to another purpose than dry-pressing, as it appears by the following statement. The patent is for a "Dry-Press and Sheet-Tie," and the evidence shows that, while prior to the invention in suit dry-pressing was always done by the printer before the folding of the sheets and the delivery of them to the binder, it was the practice, in the bindery, to tie up the dry-pressed and folded sheets in bundles for storage; this operation being usually done by hand, but, in the Palmer Bindery, having to some extent been aided by the use of an upright press. The patented press may thus be used in the bindery as a mere sheet-tying machine, for the bundling of sheets already dry-pressed, or it may be used for the operation of dry-pressing, in which case further bundling is unnecessary; but with the difference that, in the former use, the ends of the bundles required only protection from dirt and the cutting of the sheets by the tying cord—which protection was customarily afforded by the use of additional paper or pieces of pasteboard—while in the latter, the rigid end boards are required for the purpose of distributing and keeping distributed the pressure over the whole area of the printed pages.

On account of the errors above referred to, and to the end that equity may be done and that this Court may, upon fuller consideration and with the advantage of oral argument, revise its said judgment (if revision be right and proper), your petitioners pray that the Court may be pleased to take their Petition into consideration, and to grant a rehearing upon the question of the validity of the fifth claim of the said Let-

ters Patent, and to grant such other relief and order as in equity and good conscience may be proper.

M. W. JACOBS,
Counsel for Appellees.

I certify that, in my opinion, the foregoing Petition for a rehearing is well-founded and that the same is not made for the purpose of delay.

M. W. JACOBS,
Counsel for Appellees.